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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,013	01/18/2006	Johann Billiani	11885-00074-US	5442

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EXAMINER	
PEPITONE, MICHAEL F	

ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/565,013	BILLIANI ET AL.	
	Examiner	Art Unit	
	MICHAEL PEPITONE	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☒ Claim(s) *8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/18/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 8 is objected to because it is dependent from claims 5 and 7.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the half-esters" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Billiani *et al.* (US 5,698,625).

Regarding claim 1: Billiani *et al.* teaches a water dilutable alkyd resin (1:39-2:11) comprising unsaturated fatty acids (3:7-12) which are bonded via ester groups (3:23-25) to a copolymer comprising vinyl monomers and alkyd resin (2:55-3:6; 3:13-19).

Regarding claim 2: Billiani *et al.* teaches fatty acids in an amount of 30-70 wt% (2:55-3:6; 4:30-5:13).

Regarding claim 3: Billiani *et al.* teaches vinyl monomers comprising carboxyl groups in an amount of about 12 to 40% {as calculated by examiner} (1:39-2:11).

Regarding claim 4: Billiani *et al.* teaches unsaturated fatty acids in an amount of 25-50%, based on the amount of vinyl monomers (1:39-53).

Regarding claim 5: Billiani *et al.* teaches about 1 to 7% {as calculated by examiner} (meth)acrylate monomers comprising oxyalkylene groups (1:39-2:11; 2:32-44).

Regarding claim 6: Billiani *et al.* teaches the basic claimed composition [as set forth above with respect to claim 1].

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a hydroxyl number of 5-150 mg/g and a Staudinger index of 8 to 15 cm^3/g, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 9: Billiani *et al.* teaches emulsifying the neutralized alkyd resin in water (3:38-43; 4:20-26) for paint formulations (5:14-32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billiani *et al.* (US 5,698,625), as applied to claims 1 and 9 above.

Regarding claim 7: Billiani *et al.* teaches the basic claimed composition [as set forth with respect to claim 1] prepared by esterifying polyalcohols having 2-6 hydroxy groups, aromatic and/or aliphatic dicarboxylic acids, cyclic and/or polycyclic carboxylic acids, and unsaturated fatty acids (1:39-2:11; 3:23-37; 3:61-4:5; 4:11-16); and further reacting with a reaction product {a copolymer} comprising vinyl monomers having carboxyl groups, vinyl monomers without

hydroxyl nor acid groups, and free radical initiators (1:39-2:11; 3:23-37; 3:61-4:5; 4:11-16; 4:30-5:13), under esterification conditions to yield a water dispersible alkyd resin (3:23-37; 4:11-16; 4:30-5:13).

Billiani *et al.* does not teach process steps in the same order of instant claim 7. However, a prima facie case of obviousness exists where changes in the sequence of adding ingredients derived from the prior art process steps. *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results*); In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.) [See MPEP 2144.04].

Regarding claim 8: Billiani *et al.* teaches (meth)acrylate monomers comprising oxyalkylene groups (1:39-2:11; 2:32-44).

Regarding claim 10: Billiani *et al.* teaches the basic claimed method [as set forth with respect to claim 9], wherein pigmented paints are prepared by dispersing pigments in the emulsion (3:44-51; 4:30-5:13).

Billiani *et al.* does not teach dispersing pigments prior to neutralization of the alkyd resin. However, a prima facie case of obviousness exists where changes in the sequence of adding ingredients derived from the prior art process steps. *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959). See also *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results*); In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.) [See MPEP 2144.04].

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MFP
24-March-08

/David Wu/
Supervisory Patent Examiner, Art Unit 1796